REMARKS

Present Status of Application

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all claims 1-31.

Response to Rejections under 35 U.S.C. 101

Claims 5, 9, 11, 21, 24, and 26 were rejected under 35 U.S.C. § 101. Applicant has cancelled these claims.

Response to Rejections under 35 U.S.C. 112

The Office Action rejected claims 3 and 11 under 35 U.S.C. § 112, second paragraph. In response, claim 11 is cancelled, and claim 3 is amended to overcome the rejections.

Response to Rejections under 35 U.S.C. 102

Claims 1, 3, 4, 10, 12, 16, 17, 19, 20, 25, 27 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by Pape et al (U.S. Pub. 2002/0122715). Among these rejected claims, claims 1 and 17 are independent. Remarks are provided regarding to patentability of the independent claims and claims depended thereto, respectively.

Response to rejections of claim 1 and claims depended thereto (claims 2-16).

Claim 1 expressly recites:

> 1. A method of releasing product for shipping, comprising:
> providing a computer having a memory and a number of user inputs;
> providing a product storage unit;
> providing an exit control station;

providing a printer;
providing a product release information source;
feeding product release information into said computer from said product release information source;
storing said product release information in said computer memory;
entering a shipping request into one of said user inputs of said computer by a user wherein said shipping request comprises instructions to ship a quantity of product to a customer;
transmitting instructions from said computer to said product storage unit, said printer, and said exit control station to ship said quantity of product;
transmitting product release information related to said quantity of product from said computer memory to said product storage unit, said printer, and said exit control station;
printing a product release form for said quantity of product by said printer using said product release information transmitted to said printer by said computer;
locating said quantity of product in said product storage unit, attaching said product release form, and preparing said quantity of product for shipping;
transporting said quantity of product to said exit control station;
verifying said quantity of product has said product release form attached and is the same said quantity of product identified by shipping request at said exit control station; and
shipping said quantity of product if said quantity of product has said product release form attached and is the same said quantity of product identified by said shipping request.

(*Emphasis added*). Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

In contrast, Pape et al. teach a method for preparing items for shipment in a distribution facility with multiple pallet-build squares may include a step of identifying an available pallet-build square among the multiple pallet-build squares. An item may then be transported to an operator for the available pallet-build square. Item data from a scan of a barcode on the item may then be received, and in response, a display may be automatically updated to identify the available pallet for the operator.

The embodiment of claim 1 defines a method of shipping a quantity of product using computer controlled electronic system to generate shipping requests, control the shipping

activity, and to prepare the required forms for shipping. Additionally, the claimed embodiment provides a computer controlled electronic system for shipping a quantity of product, controlling the shipping activity, and preparing the required forms for shipping.

In contrast, the system and method taught by Pape relates to a manufacturing facility that provides build-to-order products and direct shipment of products to customers. More specifically, the system and method taught by Pape relates to a manufacturing facility that is constructed and operated in such a manner as to enjoy numerous benefits, relative to prior art manufacturing facilities, including the benefit of reduced production costs and inventory costs. In addition, the system and method taught by Pape may be utilized to advantage in a distribution facility, independent of the manufacturing process.

The invention of claim 1 and Pape deal with different problems. Additionally, the features taught by Pape cannot achieve the beneficial results obtained by the claimed invention.

For the reasons described above, the teachings of claim 1 cannot be anticipated by Pate. Claim 1, therefore patently defines over the cited art, and the rejections of claim 1 should be withdrawn.

Claim 1 serves as the base claim for claims 2-16, which patently defines over the cited art, and the teachings of claims 2-16 cannot be obtained by the teachings of the cited art. Therefore, the rejections of claims 3, 4, 10, 12, and 16 therefore, should be withdrawn.

Response to rejections of claim 17 and claims dependent therefrom (claims 18-31).

Claim 17 defines a system for releasing product for shipping. A computer has a memory and a number of user inputs. A product storage unit has a control unit in communication with said computer. An exit control station has a control unit in communication with said computer.

A printer is in communication with said computer. A product release information source is also provided. A means for feeding product release information into said computer memory from said product release information source is also provided. A means for entering a shipping request into one of said user inputs of said computer by a user is provided, wherein said shipping request comprises instructions to ship a quantity of product to a customer. Means for instructing said printer to print a product release form for said quantity of product is provided. A means for locating said quantity of product in said product storage unit, attaching said product release form to said quantity of product, and preparing said quantity of product for shipping. A means for transporting said quantity of product to said exit control station is provided. A means for verifying whether said quantity of product has said product release form attached and is the same said quantity of product identified by said shipping request at said exit control station is provided. A means for shipping said quantity of product if said quantity of product has said product release form attached and is the same said quantity of product identified by said shipping request is provided.

In contrast, the system and method taught by Pape relates to a manufacturing facility that provides build-to-order products and direct shipment of products to customers. More specifically, the system and method taught by Pape relates to a manufacturing facility that is constructed and operated in such a manner as to enjoy numerous benefits, relative to prior art manufacturing facilities, including the benefit of reduced production costs and inventory costs. In addition, the system and method taught by Pape may be utilized to advantage in a distribution facility, independent of the manufacturing process.

The embodiments claimed in claim 17 and Pape deal with different problems. Additionally, the features taught by Pape cannot achieve the beneficial results obtained by the claimed invention.

For the reasons described above, Pape is not a proper anticipatory reference to claim 17. Claim 17, therefore patently defines over the cited art, and the rejections of claim 17 should be withdrawn.

Claim 17 serves as the base claim for dependent claims 18-31. As claim 17 defines over the cited art, claims 18-31 patently define over the cited art for at least the same reasons.

Response to Rejections under 35 U.S.C. 103

Claims 2 and 18 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Pape et al (U.S. Pub. 2002/0122715) in view of Duncan et al (U.S. Pub. 2003/0083890). Claims 5, 9, 11, 13, 14, 21, 24, 26, and 28-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pape et al (U.S. Pub. 2002/0122715). Claims 6-8, 15, 22, and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pape et al (U.S. Pub. 2002/0122715) in view of Petkovset (U.S. Pat. 6863310).

Response to rejections of claims 2 and 18

Claim 2 is dependent upon claim 1 and claim 18 is dependent upon claim 17. As described above, technical features of claims 1 and 17 are not taught by Pape.

Claim 2 teaches a method further comprising taking corrective action if said quantity of product does not have said product release form attached or is not the same said quantity of product identified by said shipping request.

Claim 18 teaches the system of claim 17 further comprising means for taking corrective action if said quantity of product does not have said product release form attached or is not the same said quantity of product identified by said shipping request.

Duncan et al (U.S. Pub. 2003/0083890) teaches a method and system for the automated packing of products, such as ophthalmic lens product cartons, using various identifiers associated with a particular order to track the shipping container and its filling with component contents. The claimed embodiment also pertains to a dunnage article.

Claims 2 and 18 cannot be obtained by combining the teachings of Pape and Duncan. The rejections of claims 2 and 18, therefore, should be withdrawn.

Response to rejections of claims 5, 9, 11, 13, 14, 21, 24, 26, and 28-31

Claims 5, 9, 11, 13, 14 are dependent to claim 1; claims 21, 24, 26, and 28-31 are dependent to claim 17. As described above, technical features of claims 1 and 17 are not taught by Pape.

Claims 5, 9, 11, 21, 24, 26 are cancelled.

As described above, teachings of claims 1 and 17 are not properly anticipated by the teachings of Pape. The claims dependent upon claims 1 and 17 cannot be obtained by combining the teachings of Pape and other cited art. Accordingly, the rejections of claims 13, 14, and 28-31 therefore, should be withdrawn.

Response to rejections of claims 6-8, 15, 22, and 23

Claims 6-8, 15 are dependent to claim 1; claims 22 and 23 are dependent to claim 17. As described above, technical features of claims 1 and 17 are not taught by Pape.

Claim 6 teaches the method of claim 1 wherein said transmitting said product release information to said printer includes instructions to print a digital stamp on said product release form.

Claim 7 teaches the method of claim 1 wherein said product release form includes a digital stamp.

Claim 8 teaches the method of claim 1 wherein said product release form includes a customs declaration.

Claim 15 teaches the method of claim 1 wherein said product release information includes information required to produce a digital stamp and a customs declaration form.

Claim 22 teaches the system of claim 17 wherein said transmitting said product release information to said printer includes instructions to print a digital stamp on said product release form.

Claim 23 teaches the system of claim 17 wherein said transmitting said product release information to said printer includes instructions to print a customs declaration on said product release form.

In contrast, Petkovset (U.S. Pat. 6,863,310) teaches a mailing assembly for use in connection with non-domestic delivery of a mailpiece wherein the sender of the mailpiece is required to complete a sender's declaration. The assembly includes a mailing form that may be sub-divided into customs declarations forms, a dispatch notice and a backing sheet. The backing sheet may be peeled off the mailing form exposing adhesive on the backing sheet. The backing sheet may be folded in such a way as to provide an envelope to adhere to the mailpiece to be non-domestically delivered. The customs declarations forms and, dispatch notice may then be inserted into the envelope whereupon the mailpiece may be non-domestically delivered. The

customs declaration forms and dispatch notice of the mailing form may be variably printed with information to aid in the non-domestic delivery of the mailpiece.

Claims 6-8, 15, 22, and 23 cannot be obtained by combining the teachings of Pape and Petkovset. For at least this reason, the rejections of claims 2 and 18, therefore, should be withdrawn.

As a separate and independent basis for the patentability of independent claims 6-8, 15, 22, and 23, Applicants respectfully traverse the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious because "Petkovsek provides the motivation that the digital stamp aids in the delivery of non-domestic mail and provides a record for the sender and sender and shipping authority that the mail reached it destination." (Office Action, p. 8) This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an electronic customs release slip, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998);

Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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